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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,057	03/23/2004	David M. Brooke	016295.1595	4038

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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,057	BROOKE ET AL.	
	Examiner	Art Unit	
	Adam M Queler	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03/23/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application and Preliminary Amendment filed 10807057.

2. Claims 1-10 are pending in the case. Claims 1, 5, 8 are independent claims.

Specification

3. The applicant is required to update the serial numbers and status of ALL related applications as exemplified on page 1 of the specification.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 1, 5, and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,748,569.** Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5, and 8 of the patent contain every element of claim 1of the instant application and as such anticipates claims 1, 5, and 8 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

6. Claims 2, 3, 6, 7, 9, and 10 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,748,569 in view of Bayeh et al. (USPN 6012098, filed 2/23/1998).

Regarding dependent claims 2, 6, and 9, the patented claims do not teach transforming. Bayeh teaches transforming the first and second documents into an XML document (col. 11, ll. 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to transform the documents into XML since they contained information intended to be used in the XML document.

Regarding dependent claim 3, 7, and 10, the patented claims do not teach converting. Bayeh teaches converting the XML document to an output document for a selected display (col. 11, l. 53 – col. 12, l. 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to convert to an output document so that the document could be viewed.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 5-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a computer program product. A computer program product does not include a computer readable medium *per se;* therefore the claims are not tangibly embodied.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayeh et al. (USPN 6012098, filed 2/23/1998), and further in view of Monday et al. (US006480860B1, filed 2/11/1999).

Regarding independent claims 1, 5, and 8, Bayeh teaches a script (servlet) for generating content to be included into a XML document (col. 10, ll. 46-58). Bayeh teaches the scripts are Java servlets. Java servlets must inherently have exception handling which constitutes a control statement. Bayeh also discloses using a document, a DTD that specifies the style of the content in the XML document (col. 11, ll. 1-5). Bayeh teaches the purpose of the DTD is to format the data by inserting the tags that relate to the content from the database, such as <email> (col. 11, ll.

14-19). Bayeh does not explicitly disclose generating the DTD. Monday teaches generating a DTD from a database schema (col. 1, ll. 51-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the DTD of Bayeh, with the generated DTD of Bayeh, so that the DTD could be dynamically generated for new data types (Monday, col. 7, ll. 32-40), and so that the database and document would correspond (Bayeh, col. 11, ll. 14-19).

Regarding dependent claims 2, 6, and 9, Bayeh teaches transforming the first and second documents into an XML document (col. 11, ll. 1-3).

Regarding dependent claim 3, 7, and 10, Bayeh teaches converting the XML document to an output document for a selected display (col. 11, l. 53 – col. 12, l. 12).

Regarding dependent claim(s) 4, Bayeh teaches a plurality of user scripts that further generate that first and second documents in the same manner as cited in the rejection of claim 1 (col. 9, ll. 30-63).

11. Claims 1, 5 and 8 are additionally rejected under 35 U.S.C. 103(a) as being unpatentable over "Extensible Sever Pages Layer 1" by Stefano Mazzocchi hereinafter Mazzocchi.

This rejection may be overcome by filing a similar Declaration under 37 C.F.R 1.131 to the one that was filed in the parent application.

Regarding independent claims 1, 5, and 8, it is the position of the Office that, in Mazzocchi, the XML source in the "Example of Usage" on page 5 together with the logic sheet on page 6 constitutes Mazzocchi disclosing a script, which inherently must be generated. Mazzocchi also discloses that when processed it generates a document that specifies the content and style to be included in the XML document (p. 7-8). Mazzocchi also teaches that it doesn't matter how

many transformations the page goes through. Mazzocchi does not teach that the content and the style specifications should be in two different documents. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have to content in a separate file to be merged before the final file was displayed, due to the fact that it does not matter how may times the data is transformed.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

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